

REMARKS

In the Final Office Action¹, the Examiner:

1. rejected claims 2-5, 7, 10, 11, 16, 18-22, 24, 27, 28, 33-37, 39, 42, 43, 48-50 and 52 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,124,197 to Ocepek et al. ("*Ocepek*"), in view of U.S. Patent No. 7,295,524 to Gray et al. ("*Gray*"), and further in view of U.S. Patent No. 6,580,712 to Jennings et al. ("*Jennings*");
 2. rejected claims 6, 23, and 38 under 35 U.S.C. § 103(a) as being unpatentable over *Ocepek*, *Gray*, *Jennings*, and further in view of U.S. Patent No. 6,009,423 to Moran ("*Moran*");
 3. rejected claims 8, 25, and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Ocepek*, *Gray*, *Jennings*, and further in view of U.S. Patent No. 7,174,373 to Lausier ("*Lausier*"); and
 4. rejected claims 9, 26, and 41 under 35 U.S.C. § 103(a) as being unpatentable over *Ocepek*, *Gray*, *Jennings*, *Lausier*, and further in view of U.S. Patent Application Publication No. 2003/0101353 to Tarquini et al. ("*Tarquini*").
- Applicant has amended claims 2, 18, 19, 34, 49, 50, and 52. Claims 2-11, 16, 18-28, 33-43, 48-50, and 52 remain pending and under current examination.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

I. Rejection of claims 2-5, 7, 10, 11, 16, 18-22, 24, 27, 28, 33-37, 39, 42, 43, 48-50 and 52

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 2-5, 7, 10, 11, 16, 18-22, 24, 27, 28, 33-37, 39, 42, 43, 48-50 and 52 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established with respect to these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the

prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

In this application, a *prima facie* case of obviousness has not been established because the Examiner has not clearly articulated a reason why one of ordinary skill would find the claimed combination obvious in view of the cited references.

For example, claim 2 recites a method comprising, *inter alia*:

searching the identifiers, wherein a more frequently encountered predetermined percentage of identifiers is searched first;

...

comparing the determined operating system with one or more stored operating systems, such that at least one of the stored operating systems corresponds to the wireless access device; and indicating that the received packet corresponds to the wireless access device based on the first three octets of the received address and when the determined operating system matches at least one of the stored operating systems.

(Emphasis added).

Ocepek discloses security device 10 that “passively monitors the data link layer for new client devices 24” (col. 5, lines 14-15). “The source MAC address is dependent upon the operating system and hardware of protected servers 16” (col. 7, lines 43-44).

Any address that may exist in Fig. 6 of *Ocepek* corresponds to the source MAC address that depends on servers 16. Accordingly, any packet indication that may exist in *Ocepek* indicates that the packet is dependent on servers 16, not client devices 24, alleged by the Examiner to correspond to the claimed “wireless access device.”

Therefore, neither server 16 nor any other component of *Ocepek* corresponds to the claimed "wireless access device," as asserted by the Examiner.

Ref. 20 in *Ocepek* is a wireless access point that provides client devices 24 access to network 12. The use of wireless access point 20 to provide client devices 24 access to network 10 does not support a contention that server 16 corresponds to the claimed "wireless access device," at least because one of ordinary skill would recognize that a server is not a "wireless access device." Therefore, *Ocepek* does not teach or suggest the claimed "wireless access device," as recited in claim 2.

In addition, *Ocepek* does not teach or suggest the claimed "searching the identifiers, wherein a more frequently encountered predetermined percentage of identifiers is searched first," as further recited in claim 2.

Gray does not cure the deficiencies of *Ocepek*. *Gray* discloses "WLAN air space mapping" (col. 3, lines 8-9). *Gray* does not teach or suggest "searching the identifiers, wherein a more frequently encountered predetermined percentage of identifiers is searched first," as recited in claim 2.

Jennings does not cure the deficiencies of *Ocepek* and *Gray*. *Jennings* discloses "the use of a specific or dedicated engine to execute the algorithm" (col. 2, lines 50-51). In *Jennings*, "[t]he LRU scheme tunes a look-up database over time so as the most frequently used MAC addresses move to the start of the linked lists" (col. 5, lines 50-52).

Jennings does not teach or suggest the claimed "organizationally unique identifiers." Accordingly, *Jennings* does not teach or suggest "storing one or more organizationally unique identifiers that consist of the first three octets of one or more

registered addresses.” In addition, while *Jennings* may disclose moving MAC addresses to the start of linked lists, *Jennings* does not teach or suggest the claimed “predetermined percentage.” Therefore, *Jennings* does not teach or suggest “wherein a more frequently encountered predetermined percentage of identifiers is searched first,” as further recited in claim 2.

Accordingly, *Ocepek*, *Gray*, and *Jennings* do not teach or suggest the elements of claim 2. Moreover, there is no teaching or suggestion that would lead one of ordinary skill in the art to modify the apparatus of *Ocepek*, *Gray*, and *Jennings* to achieve the combination of claim 2. Thus, as outlined above, the Office Action has neither properly determined the scope and content of the cited references nor properly ascertained the differences between the cited references and the claimed invention. Therefore, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the cited references and a *prima facie* case of obviousness has not been established with respect to claim 2.

Thus, claim 2 is allowable for at least these reasons, and claims 3-5, 7, 10, 11 and 16 are also allowable at least due to their dependence from claim 2.

Independent claims 18, 19, 34, 49, 50, 52, while of different scope, recite features similar to those of claim 2 and are thus allowable over *Ocepek*, *Gray*, and *Jennings* for at least reasons similar to those discussed above in regard to claim 2. Moreover, claims 20-22, 24, 27, 28, 33, 35-37, 39, 42, 43, and 48 are also allowable at least due to their dependence from one of claims 19 and 34.

II. Rejection of claims 6, 23, and 38 under 35 U.S.C. § 103(a)

Regarding the rejection of claims 6, 23, and 38, which depend from claims 2, 19, and 34, the Examiner relies on *Moran* for allegedly disclosing “comparing based on determination of whether a portion of the address is similar to a portion of at least one of the registered addresses” (Final Office Action at page 17). Even assuming this allegation is correct, which Applicant does not concede, *Moran* fails to cure the deficiencies of *Ocepek*, *Gray*, and *Jennings* with respect to the independent claims.

Therefore, a *prima facie* case of obviousness has not been established for claims 6, 23, and 38 and the Examiner should withdraw the rejection of the claims under 35 U.S.C. § 103(a).

III. Rejection of claims 8, 25, and 40 under 35 U.S.C. § 103(a)

Regarding the rejection of claims 8, 25, and 40, which depend from claims 2, 19, and 34, the Examiner relies on *Lausier* for allegedly disclosing “determining the operating system at the IP address associated with the address” (Final Office Action at page 18). Even assuming this allegation is true, which Applicant does not concede, *Lausier* fails to cure the deficiencies of *Ocepek*, *Gray*, and *Jennings* with respect to the independent claims.

Therefore, a *prima facie* case of obviousness has not been established for claims 8, 25, and 40 and the Examiner should withdraw the rejection of the claims under 35 U.S.C. § 103(a).

IV. Rejection of claims 9, 26, and 41 under 35 U.S.C. § 103(a)

Regarding the rejection of claims 9, 26, and 41, which depend from claims 2, 19, and 34, the Examiner relies on *Tarquini* for allegedly disclosing "determining the operating system using an nmap" (Final Office Action at page 18). Even assuming this allegation is true, which Applicant does not concede, *Tarquini* fails to cure the deficiencies of *Ocepek*, *Gray*, *Jennings*, and *Lausier* with respect to the independent claims.

Therefore, a *prima facie* case of obviousness has not been established for claims 9, 26, and 41 and the Examiner should withdraw the rejection of the claims under 35 U.S.C. § 103(a).

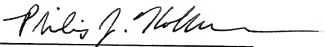
V. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

Dated: March 16, 2009

By: 
Jeffrey A. Berkowitz
Reg. No. 36,743

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
(202) 408-4000

Philip J. Hoffmann
Registration No. 46,340